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EXAMINER

HANNE, SARA M

ART UNIT PAPER NUMBER

2179

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,605

Applicant(s)

RICART ET AL.

Examiner

Sara M. Hanne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment received on September 11, 2006.

Claims 1-5 and 7-15 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7, line 2 still recites the phrase "durably store". The term "durable" is meant to describe something with tangible strength or capability to withstand wear or decay. What is durable about information? Claims 8-11 are rejected because they rely upon rejected Claim 7.

Claim Rejections - 35 USC § 103

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over East et al., U.S. Patent Publication No. 2003/0061323, hereinafter East, and further in view of Capps et al., US Patent 6735691, hereinafter Capps.

As in Claim 1, East teaches storing personalization information at a second server (highest server stores updates); adding at least one new client computer to the network (pg. 6, par 60); and in response to determining the client exists, sending personalization information from said second server to said first server, and from said first server to said new client computer such that said new client computer is personalized (pg. 5, par 57 and pg. 6, par 60). While East teaches information propagation and personalization method, they fail to explicitly teach the gathering personalization information from plural client computers on the network and from a first server on the network during operation of said network; determining that said at least one new client computer is intended to replace at least one of said plural client computers as recited in the claims. In the same field of the invention, Capps teaches a computer personalization through server control similar to that of East. In addition, Capps further teaches gathering personalization information from plural client

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computers on the network and from a first server on the network during operation of said network (Fig. 1, and corresponding text); determining that said at least one new client computer is intended to replace at least one of said plural client computers (Fig. 5-6, and corresponding text). It would have been obvious to one of ordinary skill in the art, having the teachings of East and Capps before him at the time the invention was made, to modify the information propagation and personalization method taught by East to include the gathering personalization information from plural client computers on the network and from a first server on the network during operation of said network; determining that said at least one new client computer is intended to replace at least one of said plural client computers of Capps, in order to obtain the method comprising replacing a client computer with a new client computer and personalizing the new computer by using personalization information gathered from the network stored on a second server. One would have been motivated to make such a combination because a hardware updating system that preserves user personalization and settings would have been obtained, as taught by Capps (Col. 1, lines 23 et seq.).

Claim 2 East teaches that the information sent must be at least one of "the first server's name, the domain in which it resides . . ." etc. taught by East by configuring the network ("changing TCP/IP configurations", Pg. 5, Par. 54).

Claim 3 East also teaches that the information sent can be Windows operating system registry information. East teaches this limitation by installing a new device ("an operating system update, the addition of a new device driver, a change in device settings", Pg. 4, Par. 50). Also, the background art in this patent application does refer

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to prior art listed on novell.com in the form of software that can collect the Desktop policies and profiles, which would include registry information and corporate policy information.

As in Claim 4, East teaches personalizing the first server after the client has been personalized (see in the rejection of Claim 7 *below*). Therefore the system ignores workstation requests for personalization until the server is personalized.). While East teaches information propagation and personalization method, they fail to explicitly teach they fail to explicitly teach the personalization information for the server and client being different as recited in the claims. In the same field of the invention, Capps teaches a computer personalization through server control similar to that of East. In addition, Capps further teaches gathering personalization information from plural client computers on the network and from a first server on the network during operation of said network (Fig. 1, and corresponding text) therefore the personalization information for the server and client would be different (two different devices have different user ids, passwords, settings etc.). It would have been obvious to one of ordinary skill in the art, having the teachings of East and Capps before him at the time the invention was made, to modify the information propagation and personalization method taught by East to include the personalization information for the server and client being different of Capps, in order to obtain the method comprising replacing a client computer with a new client computer and personalizing the new computer by using personalization information gathered from the network stored on a second server, the personalization information for the server and client being different. One would have been motivated to make such

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a combination because a customized hardware updating system that preserves user personalization and settings would have been obtained, as taught by Capps (Col. 1, lines 23 et seq.).

As in Claim 5, East teaches personalizing the client as seen in the rejection of Claim 1 *supra*. East and Capps fail to explicitly teach ignoring user requests until the client is at least partially personalized as recited in the claims. It would be obvious to one of ordinary skill in the art to ignore user requests temporarily until the client has been personalized at least partially. One would have been motivated to make such a combination because a personalization method that is executed long enough so that it may complete the request of the user would have been obtained.

As in Claim 7, East further discloses the server to receive and durably store ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39) the personalization information for the Server and for the Client, the server personalizing itself according to this information, sending the Client it's information, and the Client personalizing itself based on the information it receives ("Remote/master administrative server 202B then conveys the update to remote server 202C and thin clients 200C-D. Remote server 202C then conveys the update to thin clients 202E-N.", Pg. 5, Par. 50) and to durably store the client personalization information ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39). While East teaches the method comprising personalizing a server before the server provides client personalization information to the client, the client configured to

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personalize itself using client personalization information, they fail to explicitly teach the personalization information for the server and client being different as recited in the claims. In the same field of the invention, Capps teaches a computer personalization through server control similar to that of East. In addition, Capps further teaches gathering personalization information from plural client computers on the network and from a first server on the network during operation of said network (Fig. 1, and corresponding text) therefore the personalization information for the server and client would be different (two different devices have different user ids, passwords, settings etc.). It would have been obvious to one of ordinary skill in the art, having the teachings of East and Capps before him at the time the invention was made, to modify the method comprising personalizing a server before the server provides client personalization information to the client, the client configured to personalize itself using client personalization information taught by East to include the personalization information for the server and client being different of Capps, in order to obtain the method comprising personalizing a server before the server provides client personalization information to the client, the client configured to personalize itself using client personalization information, the personalization information for the server and client being different. One would have been motivated to make such a combination because a customized hardware updating system that preserves user personalization and settings would have been obtained, as taught by Capps (Col. 1, lines 23 et seq.).

As in Claim 8, East teaches the client to be a laptop disconnectable from the server ("LAN 104 may include a number of interconnected computer systems and

optionally one or more other devices: for example, one or more workstations 110a, one or more personal computers 112a, one or more laptop or notebook computer systems 114, one or more server computer systems 116, and one or more network printers 118.", Pg. 3, Par. 36).

As in Claim 9, East teaches a higher-tier server that receives personalization information for the client's server and provides this information back to the server after the server receives and durably stores ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39) it and at least partially personalizes itself using this information ("an administrative server is a computer that controls updates and configurations for one or more other administrative servers and/or one or more thin clients", Pg. 4, Par. 50).

As in Claims 10 and 11, East teaches transmission of Roles and Workstation information as further described in Claim 7 of the application seen *supra*. East and Capps fail to explicitly teach one piece of information to be dominate or submissive to another. It would be obvious to one of ordinary skill in the art to make a specific piece of information, roles workstation or user information, dominate or submissive. One would have been motivated to make such a combination because a personalization method for controlling the order in which the information is processed would have been obtained.

As in Claim 12, East teaches collecting and storing server and client personalization information pertaining to the existing server and client, sending the personalization information to a new server (Copy Configuration, Pg. 5, Par. 56-58) to

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personalize the server with the other server's information, storing the personalization information by the server ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39, sending the personalization information for the Client to a new client to personalize the client with the other client's information ("plug-and-play customization for new clients.", Pg. 6, Par. 60) and storing the personalization information that pertains to the client in a durable way ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39).

While East teaches the method comprising personalizing a server before the server provides client personalization information to the client, the client configured to personalize itself using client personalization information, they fail to explicitly teach the client server personalization information being different and new client/server to be replacements for the old client/server as recited in the claims. In the same field of the invention, Capps teaches a computer personalization through server control similar to that of East. In addition, Capps further teaches gathering personalization information from plural client computers on the network and from a first server on the network during operation of said network (Fig. 1, and corresponding text) therefore the personalization information for the server and client would be different (two different devices have different user ids, passwords, settings etc.) and new client/server to be replacements for the old client/server (Fig. 5-6 and corresponding text). It would have been obvious to one of ordinary skill in the art, having the teachings of East and Capps before him at the time the invention was made, to modify the method comprising collecting personalization information for a client/server, sending the information to the

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server, personalizing the server, sending information for the client to the client from the server and personalizing the client taught by East to include the personalization information for the server and client being different and new client/server to be replacements for the old client/server of Capps, in order to obtain the method comprising collecting personalization information for an existing client/server, sending the information to the server, replacing the existing client/server with a new client/server, personalizing the new server, sending information for the new client to the new client from the new server and personalizing the new client, the personalization information for the server and client being different. One would have been motivated to make such a combination because a customized hardware updating system that preserves user personalization and settings would have been obtained, as taught by Capps (Col. 1, lines 23 et seq.).

In reference to Claim 13, East teaches the personalization information to be stored with a remote service provider (Remote/master administrative server 202B).

In reference to Claim 14, East teaches the personalization information to include roles information (Figure 8 clusters, and MAC address), net information ("network management information can be transferred", Pg. 8, Par. 90), client information (Claim 7 rejection *supra*) and user information ("change in device settings", Pg. 4, Par. 50).

In reference to Claim 15, East teaches the role information comprising personalization information common to or driven by roles or functions within a company. They further teach the net information comprising personalization information common to a workgroup, network, or server, along with client information comprising

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personalization information specific to the client and user information comprising information specific to a user (see Claim 14 rejection, *supra*).

Response to Amendment

Applicant's arguments with respect to claims 1-5, 7-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M. Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh



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SUPERVISORY PATENT EXAMINER